



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Address: COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, Virginia 22313-1450

[www.uspto.gov](http://www.uspto.gov)

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/817,837	03/26/2001	G. Eric Engstrom	112076-138339	9404
25943 7590 04/30/2010 Schwabe Williamson & Wyatt PACWEST CENTER, SUITE 1900 1211 SW FIFTH AVENUE PORTLAND, OR 97204				
EXAMINER				
THOMPSON, MICHAEL M				
ART UNIT		PAPER NUMBER		
3629				
MAIL DATE		DELIVERY MODE		
04/30/2010		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

09/817,837

**Applicant(s)**

ENGSTROM, G. ERIC

**Examiner**

Michael M. Thompson

**Art Unit**

3629

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 15 January 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 45-63, 69-72 and 74-78 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 45-63, 69-72 and 74-78 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SEA-3)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date \_\_\_\_\_

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. **Claims 45-74 are rejected under 35 U.S.C. 102(e) as being anticipated by Shiloh (US 2001/0037316) or Shiloh (US 7412422).**
3. **With respect to claim 45**, both Shiloh references teach a method of operation, performed by a device, comprising: receiving by the device (i.e. either the user computer itself or the RU/VU database computer/server for example, col. 4 and 16 or the Figures), from a first server of a first service provider, a request for registration information (i.e. the idea of Shiloh being used for registration purposes and transacting in col. 4, lines 30-41, and as defined under "real entity", "real personality" or "real user"), the registration information requested including one or more personality characteristics (i.e. Inherent in registration process due to the broadest reasonable interpretation of personality characteristics such as but not limited to Shiloh's depiction of "real personality" and his teaching of the virtual personality co. 4, lines 30-41 and col. 4, line 65 thru col. 5, lines 1-7, passim); in response to the request, the device causing a second server of a second service provider to dynamically generate and provide a

personality profile having one or more personality characteristics to portray a desired persona, the one or more personality characteristics being based at least in part on content of a service provided by the first service provider, the second service provider providing a personality service; (i.e. via at least the Virtual Personality Database and/or AVPP, and figures showing the different servers such as Figure 2, wherein the registration request is the impetus to allow the systems to generate and provide the personality profile upon request) and transmitting by the device, or the device causing the second server to transmit, the personality profile to the first server to respond to the request. (i.e. this occurs for example in Figure 2 where the AVPP system or the equivalent virtual embodiment is utilized by a user to interact over the internet with registration systems mentioned above.) Please also note Col. 16 throughout the instant rejection recognizing the adaptation of profile information. Applicant(s) are reminded that optional or conditional elements do not narrow the claims because they can always be omitted. See e.g. MPEP §2106 II C: "Language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation. [Emphasis in original.]" and In re Johnston, 435 F.3d 1381, 77 USPQ2d 1788, 1790 (Fed. Cir. 2006) ("As a matter of linguistic precision, optional elements do not narrow the claim because they can always be omitted." (where the Federal Circuit affirmed the Board's claim construction of "further including that said wall may be smooth, corrugated, or profiled with increased dimensional proportions as pipe size is increased" since "this additional content did not

narrow the scope of the claim because these limitations are stated in the permissive form 'may.'")

4. **With respect to claim 46**, both Shiloh references teach the method of claim 45, wherein the method further comprises the device requesting the first service provider for information. (i.e. this is inherent Shiloh when the user computer accesses the service provider website and inherently exchanges information upon execution of the website address.)

5. **With respect to claim 47**, both Shiloh references teach the method of claim 45, wherein the personality profile is provided by the second server of the personality service provider, based at least in part on a service provided by the first service provider, and transmitted to the first server of the first service provider by the device, and the method further comprises receiving by the device, the personality profile from the second server of the personality service provider. (i.e. the thrust of the Shiloh patent is a virtual profile that is capable of providing information to the user for use in accessing websites as shown at least in the Figures.)

6. **With respect to claim 48**, both Shiloh references teach the method of claim 45, wherein the personality profile is provided by the second server of the personality service provider, and the method further comprises receiving by the device, a list of personality profiles from the second server of the personality service provider, the list having been put together by the second server of the personality service provider, based at least in part on a service provided by the first service provider, and selecting by the device, a personality profile from the list of personality profiles. (i.e. as recited in

col.8, the personality service provider and AVPP can create it's own line of virtual products to be offered to the user.)

7. **With respect to claim 49**, both Shiloh references teach the method of claim 45, wherein the personality profile is generated by the device, and transmitted to the first server of the first service provider by the device. (i.e. as in the case when the user chooses it's own custom profile, the user device (potentially designated as either the user input and users computer or RU/VU database computer. In short, the profile can be generated by the users computer through user input when registering with service providers.)

8. **With respect to claim 50**, both Shiloh references teach the method of claim 45, wherein the method further comprises requesting by the device, to initiate an e-commerce transaction with the first service provider, or to participate in a chat session hosted by the first service provider. (i.e. Col. 4 and 5)

9. **With respect to claim 51**, both Shiloh references teach the method of claim 45, wherein said one or more personality characteristics comprise at least one selected from a group consisting of a description of hobbies, a description of interests, and a biographical description. (i.e. col. 4 and 5 describe at least biographical information such as imaginary name, imaginary address in response to e-commerce or registration sites accessed by the real personality/user.)

10. **With respect to claims 52, 75 and 78**, both Shiloh references teach a method of operation, performed by a first server of a first service provider providing a personality service, comprising: receiving by the first server, from a client device, a request to

dynamically generate and provide a personality profile having one or more personality characteristics (i.e. as described in claim 45, this process is inherent in any computer to computer interaction where there is a request for information and is taught in Shiloh. This is taught when the user computer accesses the AVPP databases to request a virtual identity), for responding to a request of a second server of a second service provider, requesting for registration information, the registration information requested including the one or more personality characteristics (i.e. this is a request as described in col. 4 wherein the real personality is prompted to register and the AVPP system provides virtual identities); providing by the first server, a personality profile having the one or more personality characteristics for response, the one or more personality characteristics being based at least in part on content of a service provided by the first service provider; and transmitting by the first server to the client device or the second server the generated personality profile. (i.e. Shiloh teaches the virtual identity for use in providing information to the first server based on characteristics as described in the rejection of claims 45-51 above.) Applicant(s) are reminded that optional or conditional elements do not narrow the claims because they can always be omitted. See e.g. MPEP §2106 II C: "Language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation. [Emphasis in original.];" and In re Johnston, 435 F.3d 1381, 77 USPQ2d 1788, 1790 (Fed. Cir. 2006) ("As a matter of linguistic precision, optional elements do not narrow the claim because they can always be omitted." (where the Federal Circuit affirmed the Board's claim construction of "further including that said

wall may be smooth, corrugated, or profiled with increased dimensional proportions as pipe size is increased" since "this additional content did not narrow the scope of the claim because these limitations are stated in the permissive form 'may.'")

11. **With respect to claim 53**, both Shiloh references teach the method of claim 52, wherein said receiving comprises receiving by the first server, the one or more requested personality characteristics from the client device. (i.e. inherent when the client device such as the user computer or the RU/VU database computer provides information. The user could fill out the requested information or the information provided by the AVPP server can be used. Please note rejections above.)

12. **With respect to claim 54**, both Shiloh references teach the method of claim 52, wherein the method further comprises the first server ascertaining the service offered by the second service provider, based at least in part on a communication between a server of the second service provider and the first server. (i.e. this could be any means by which the first service provider receives the second service providers virtual identity/information. Shiloh teaches the use of the virtual identity where the second server generates an identity that is communicated to the first server. Please note rejections above.)

13. **With respect to claims 55 and 76**, both Shiloh references teach the method of claims 52 and 75 respectively, wherein said providing comprises identifying by the first server, for the client device, a plurality of personality profiles; and receiving by the first server, from the client device, a selection of one of the identified personality profiles. (i.e. as recited in col.8, the personality service provider and AVPP can create it's own



line of virtual products to be offered to the user. These identities would be offered and accepted by the user/ user's computer.)

14. **With respect to claim 56**, both Shiloh references teach the method of claim 52, wherein said providing comprises generating by the first server one or more personality profiles having the one or more personality characteristics, the one or more personality characteristics being based at least in part on a service provided by the second service provider. (As described above, the Shiloh virtual identities and personal characteristics are created in response to the information requested by the servers.)

15. **With respect to claims 57 and 77**, both Shiloh references teach the method of claims 52 and 75 respectively, wherein said one or more personality characteristics comprise at least one of a description of hobbies, a description of interests, and a biographical description. (i.e. This claim is similarly rejected as to that of claim 51.)

16. **With respect to claim 58**, both Shiloh references teach an apparatus comprising: a storage medium having stored therein a plurality of programming instructions that in response to execution by the computing device, designed to enable the apparatus to receive from a first server of a first service provider, a request for registration information, the registration information requested including one or more personality characteristics, cause a second server of a second service provider to dynamically generate and provide a personality profile having one or more personality characteristics, and transmit, or cause the second server of the personality service provider to transmit, the personality profile to the first server of the first service provider to respond to the request; and a processor coupled to the storage medium to execute

the plurality of programming instructions. (i.e. the apparatus of this claim is directed to the computer of a user for use on the internet and the programming instructions. This is merely an operating system and/or web browser all clearly taught by the use of the Shiloh invention. In the least, a process/apparatus is covered as well by the rejection of claims 45 and 52.)

17. **With respect to claim 59**, both Shiloh references teach the apparatus of claim 58, wherein said plurality of instructions are further designed to enable the apparatus to perform at least a selected one from the group consisting of requesting information from the first service provider, initiating an e-commerce transaction with the first service provider, and participating in a chat session hosted by the first service provider (i.e. This claim is rejected for the same reasons as claim 58).

18. **With respect to claim 60**, both Shiloh references teach the apparatus of claim 58, wherein said plurality of instructions are designed to enable the apparatus to request the personality service provider for the personality profile (i.e. This claim is rejected for the same reasons as claim 58).

19. **With respect to claim 61**, both Shiloh references teach the apparatus of claim 60, wherein said plurality of instructions are further designed to enable the apparatus to receive a list of personality profiles from the personality service provider, and identify for the personality service provider a selected one of the list of personality profiles (i.e. This claim is rejected for the same reasons as claim 58).

20. **With respect to claim 62**, both Shiloh references teach the apparatus of claim 58, wherein said plurality of instructions stored on a storage medium are designed to

enable the apparatus to generate the personality profile. (i.e. This claim is rejected for the same reasons as claim 58. On further note, this claim is construed to be the computer system enabling the user to create the profile when accessing the website that is requesting the information. The operating system allows a user to enter information which allows the apparatus to generate the personality profile.)

21. **With respect to claim 63**, both Shiloh references teach the apparatus of claim 58, wherein said one or more personality characteristics comprise at least one of a description of hobbies, a description of interests, and a biographical description. (i.e. This claim is similarly rejected to that of claim 51 and 57.)

22. **With respect to claim 69**, both Shiloh references teach a system comprising: a networking interface; a storage medium coupled to the networking interface, and having stored therein a plurality of programming instructions that in response to execution, cause the system to, receive from a first server of a first service provider, a request for registration information, the registration information requested including one or more personality characteristics, cause a second server of a second service provider to dynamically generate and provide a personality profile having one or more personality characteristics, the one or more personality characteristics based at least in part on content service provided by the first service provider, the second service provider providing a personality service, and transmit, or cause the second server of the personality service provider to transmit, the personality profile to the first server of the first service provider to respond to the request; and a processor coupled to the storage

medium and the networking interface to execute the programming instructions. (i.e.

This claim is similarly rejected to that of claims 45, 52, 58 and 64.)

23. **With respect to claim 70**, both Shiloh references teach the system of claim 69, wherein the programming instructions are further designed to enable the system to perform at least a selected one from the group consisting of requesting information from the first service provider, initiating an e-commerce transaction with the first service provider, and participating in a chat session hosted by the first service provider. (i.e. the examiner assumes that applicant is limiting to a group of e-commerce or chat session. Both are taught by Shiloh as referenced above.)

24. **With respect to claim 71**, both Shiloh references teach the system of claim 69, wherein the programming instructions are further designed to enable the system to receive a list of personality profiles from the personality service provider, and identify for the personality service provider a selected one of the list of personality profiles. (i.e. rejected under a software system and browser that allows this process as in claims 45, 52, 58 64 and 69.)

25. **With respect to claim 72**, both Shiloh references teach the method of claim 45, wherein prior to transmission of the personality profile by the device, the personality profile is provided to the device by the second server. (i.e. as taught in Shiloh under the AVPP system, for example, Figure 2, and referred to above.)

26. **With respect to claim 74**, both Shiloh references teach a method, comprising: accessing or attempting to access a first service provider by a user; receiving by a user, in response to the accessing or attempting to access a request for registration

information, the registration information requested including one or more personality characteristics; causing, by a user, a second service provider to dynamically generate and provide a personality profile having one or more personality characteristics to portray a desired persona, the one or more personality characteristics being based at least in part on content of a service provided by the first service provider, the second service provider providing a personality service; and transmitting by a user, or causing a server to transmit, the personality profile to the first service provider to respond to the request. (i.e. this claim is similarly rejected as to claims 45, 52, 58, 64, 69 and 73.)

27. The Declaration filed on 01/15/2010 under 37 CFR 1.131 has been considered but is ineffective to overcome the Shiloh references.

The evidence submitted is insufficient to establish a conception of the invention prior to the effective date of the Shiloh references. While conception is the mental part of the inventive act, it must be capable of proof, such as by demonstrative evidence or by a complete disclosure to another. Conception is more than a vague idea of how to solve a problem. The requisite means themselves and their interaction must also be comprehended. See *Mergenthaler v. Scudder*, 1897 C.D. 724, 81 O.G. 1417 (D.C. Cir. 1897). In Applicant's submitted Declaration, Applicant states at number five that "Exhibit 2 is a photocopy of the final application and is substantially the same as the application reviewed on or before March 19, 2001..." It is unclear as to the scope of the differences between the exhibit submitted of the final application herewith and the actual application on or before March 19, 2001, prior to the final version of exhibit 2 as filed by

counsel. For this reason the evidence is insufficient to establish conception of the invention on or before March 19, 2001.

The evidence submitted is insufficient to establish diligence from a date prior to the date of reduction to practice of the Shiloh reference to either a constructive reduction to practice or an actual reduction to practice. While the inventor has proffered statements with respect to diligence, there does not appear to be any statement of diligence as it relates to counsel. MPEP § 2138.06.

### ***Response to Arguments***

28. Applicant's arguments filed 01-15-2010 have been fully considered but they are not persuasive. At the outset, the Examiner has changed the rejection due to Applicant's deletion of specific claim language presented in an earlier response and has presented a similar rejection under 35 U.S.C. 102. Applicant should note the response to arguments as of 06/19/2009 as the status of the claims is similar. Therefore, Applicant's claim amendments have reverted back to similar language previously presented and the claims are again rejected under 35 U.S.C. 102.

### ***Conclusion***

29. The Examiner has pointed out particular references contained in the prior art of record, within the body of this action for the convenience of the Applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply.

Applicant, in preparing the response, should consider fully the entire reference as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael M. Thompson whose telephone number is (571) 270-3605. The examiner can normally be reached on Monday thru Friday 8am-5:30 except Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Michael M Thompson/  
Examiner, Art Unit 3629

/JOHN G. WEISS/  
Supervisory Patent Examiner, Art Unit 3629